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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Robert H. Wollenberg Examiner: Christopher M. Gross
Serial No.: 10/779,421 Group: Art Unit 1639
Filing Date: February 13, 2004 Docket: T-6320 (538-66)
For: HIGH THROUGHPUT SCREENING Dated: October 29, 2008
METHODS FOR LUBRICATING
OIL COMPOSITIONS

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S REPLY BRIEF

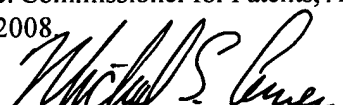
Sir:

In response to the Examiner's Answer mailed September 3, 2008, Appellant respectfully submits that based on at least the arguments provided in the Appeal Brief of May 7, 2008, appealed Claims 1-21 and 33-35 are patentable over the applied references. The following comments are respectfully submitted in order to address statements made in the Examiner's Answer.

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8 (a)

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Dated: October 29, 2008



Michael E. Carmen

I. Rejection of Appealed Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a)
as being obvious over Francisco et al. in view of Chaffee et al.

First, appellant respectfully disagrees with the Examiner's statement in section (9) on page 5 of the Examiner's Answer where the Examiner sets forth his reasoning in rejecting appealed Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. that:

"It would have been *prima facie* obvious for one of ordinary skill in the art, at the time the claimed invention was made to apply the thermal conditioning of Chaffee et al. toward the elastomer testing protocol of Francisco et al.

One of ordinary skill in the art would have been motivated to use the thermal conditioning of Chaffee et al. in the elastomer testing protocol of Francisco et al. because it would have provided an improved compression set, as noted by Chaffee et al in column 1, line 44.

One of ordinary skill in the art would have had a reasonable expectation of success in combining the thermal conditioning of Chaffee et al. with the elastomer testing protocol of Francisco et al. because Chaffee et al. had applied to thermal conditioning to silicone rubber. Therefore it would not have been unreasonable to apply thermal conditioning to the method of Francisco et al. because silicone rubber is well within the scope of synthetic rubber (elastomer seals)."

Appealed Claim 1 does not contain any limitation directed to thermal conditioning. In contrast, appealed Claim 1 recites a "high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control, comprising the steps of: (a) providing a plurality of different lubricating oil composition samples, each sample comprising (i) a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive; (b) providing at least one elastomer; (c) measuring the elastomer compatibility of each sample to provide elastomer compatibility data for each sample; and, (d) outputting the results of step (c)." Accordingly, the Examiner is incorrectly reading a limitation into the claim that is not present therein in attempting to make out a case of *prima facie* obviousness of the appealed claims.

Second, appellant respectfully disagrees with the Examiner's statement in section (9) on pages 7 and 8 of the Examiner's Answer where the Examiner further sets forth his reasoning in rejecting appealed Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. that:

“The expression “high throughput” as used herein shall be understood to mean that a relatively **large number of different lubricating oil compositions can be rapidly prepared** and analyzed.

..... Taken together, Francisco et al. in view of Chafee et al. teach at least 4500 (5x900) different combinations of elastomer and motor oil plus benzotriazole additive compositions, thus the examiner most respectfully submits Francisco et al. and Chafee et al. certainly provide a large number of different lubricating oil compositions that can be rapidly prepared, which is consistent with the definition of high throughput defined in the present specification, quoted above.” [emphasis in original]

It is submitted that the Examiner's position is entirely misplaced. The combination of Francisco et al. and Chafee et al. do not arrive at a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control as set forth in the appealed claims. In contrast, Francisco et al. disclose a lubricant composition containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further disclose in Example 3, which the Examiner has relied upon in each of the Office Actions in making this rejection, testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. The percent swell and percent change in tensile strength are calculated from these measurements and reported in Table 2 therein. However, nowhere in Example 3 is there even a remote suggestion of a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control as set forth in the appealed claims.

Chaffee et al. do not cure the deficiencies of Francisco et al. Chaffee et al. simply disclose silicone rubber compositions that are individually tested for physical properties. Thus, even by combining Francisco et al. with Chafee et al., one skilled in the art would not arrive at the claimed invention.

Third, appellant respectfully disagrees with the Examiner's statement in section (9) on pages 9 and 10 of the Examiner's Answer where the Examiner further sets forth his reasoning in rejecting appealed Claims 1-3, 5-9, 15, 16 and 21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Chaffee et al. that:

"The expression 'program control' as used herein shall be understood to mean **the equipment used herein** in providing the plurality of lubricating oil compositions is **automated** and controlled by microprocessor or other computer control device.

Emphasis added.

In this vein, the examiner submits automation of a manual activity is not patentable in accordance with MPEP 2144.04 III and *In re Venner*, 262 F2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.).

Here, in so far as "program control" set forth in claim 1 provides a plurality of lubricating oil compositions by *automating* the mechanical equipment, such as discussed in the quotation from the present specification concerning figure 2 on pp 7-8 of the appeal brief entered 6/6/2008, the examiner respectfully submits that an automatic means to replace a manual activity, which accomplished the same result (i.e. the elastomer testing protocol according to Francisco et al) is not sufficient to distinguish the presently claimed subject matter over the prior art.

In conclusion, the examiner most respectfully submits, while "high throughput" and "program control" breath life, meaning and vitality to claim 1, said limitation does not serve to adequately differentiate the present invention from the prior art according to Francisco et al. and Chaffee et al."

It is well established that the rationale to support a conclusion that the claim would have been obvious is that "a person of ordinary skill in the art would have been motivated to combine the prior art to achieve the claimed invention and that there would have been a reasonable expectation of success." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360, 80 USPQ2d 1641, 1645 (Fed. Cir. 2006). Nothing in Francisco et al. or Chafee et al. even remotely provide any suggestion or motivation to one skilled in the art to modify the references as suggested by the Examiner and arrive at a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control as set forth in the appealed claims. In addition, as previously explained in the Appeal Brief and as discussed hereinabove, the combination of Francisco et al. and Chafee et al. do not arrive at a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control as set forth in the appealed claims. Only by using Appellant's disclosure as a guide has the Examiner been able to piece together the claimed invention.

In contrast, Francisco et al. disclose a lubricant composition containing (a) a major amount of a lubricating oil basestock and (b) a minor amount of a benzotriazole for improving the load-carrying capacity of a lubricant composition under load conditions. Francisco et al. further disclose in Example 3, which the Examiner has relied upon in each of the Office Actions in making this rejection, testing a commercially available amine phosphate additive against compounds I and II from Example 2 for elastomer seal stability by measuring the volume and tensile strength of a silicone elastomer specimen before and after it is contacted with a test formulation containing the desired load additive. The percent swell and percent change in tensile strength are calculated from these measurements and reported in Table 2 therein. However, nowhere in Example 3 is there even a remote suggestion of a high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control. Chafee et al. simply disclose silicone rubber compositions that are individually tested for physical properties. Thus, as previously stated, even by combining Francisco et al. with Chafee et al., one skilled in the art would not arrive at the claimed invention.

For the foregoing reasons, the Examiner has failed to show that all of the recitations of appealed Claims 1-3, 5-9, 15, 16 and 21 are taught or suggested by the prior art. Accordingly, appealed Claims 1-3, 5-9, 15, 16 and 21 are not rendered unpatentable by Francisco et al. and Chaffee et al. and are therefore allowable.

II. Rejection of Appealed Claims 1-3, 5-9, 11-14, 17-21 and 33-35 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al.

First, appellant respectfully disagrees with the Examiner's statement in section (9) on page 6 of the Examiner's Answer where the Examiner sets forth his reasoning in rejecting appealed Claims 1-3, 5-9, 11-14, and 17-21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. that:

One of ordinary skill in the art would have been motivated to use the computer controlled robot of Kolosov et al. with the elastomer testing protocol of Francisco et al. because of the need to reduce time in analyzing samples and it would be especially attractive to rapidly test a plurality of samples on a common substrate, as noted by Kolosov et al. in paragraph 0005.

One of ordinary skill in the art would have had a reasonable expectation of success in combining the computer controlled robot of Kolosov et al. with the elastomer testing protocol of Francisco et al. because Kolosov et al. has applied the computer controlled robot toward rheological studies (e.g., viscosity or elasticity). Therefore it would not have been unreasonable to apply the computer controlled robot as part of the method of Francisco et al. because tensile strength is directly related to elasticity.

The deficiencies of Francisco et al. discussed above apply with equal force to this rejection. Kolosov et al. do not cure the deficiencies of Francisco et al. In contrast, the Examiner is attempting to fit the disclosure of Kolosov et al. into the disclosure of Francisco et al. and arrive at the claimed invention. However, Kolosov et al. provides no guidance how to screen lubricating oil composition samples for compatibility with elastomers, under program control. Rather, Kolosov et al. simply disclose in paragraph [0042] that the present invention may be used to screen or test most any material that may be a commercial product itself or may be an ingredient or portion within a commercial product such as a lubricant. Kolosov et al. further

disclose that the material such as a lubricant is tested for rheological properties. Nothing in Kolosov et al., however, would lead one skilled in the art to modify the test disclosed in Example 3 of Francisco et al. and arrive at the present claimed high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control. Only by using Appellant's disclosure as a guide has the Examiner been able to piece together the claimed invention.

Second, appellant respectfully disagrees with the Examiner's statement in section (9) on page 12 of the Examiner's Answer where the Examiner sets forth his reasoning in rejecting appealed Claims 1-3, 5-9, 11-14 and 17-21 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. that:

Regardless, assuming *arguendo* that the system presented by Kolosov et al., for whatever reason, is only applicable toward flowable samples, the examiner nevertheless submits that the claimed invention remains obvious over Francisco et al. and Kolosov et al. in view of MPEP 2143 and the recent supreme court ruling *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385 at 1396 (2007) which set forth various rationales including the use of known technique to improve similar devices (methods, or products) in the same way as being obvious. Here, the similar technique of Francisco et al. directed to testing elastomers in various motor oil compositions may be improved by a similar device comprising a robot controlled by a computer to screen and analyze samples such as afforded by Kolosov et al.

In conclusion the examiner most respectfully submits, non-flowable samples, such as presented by Francisco represent a viable sample for the sample analysis robot under computer control according to Kolosov et al. This notwithstanding, the use known technique to improve similar devices methods in the same way as being obvious under *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385 at 1396 (2007).

As discussed above, the Examiner is attempting to fit the disclosure of Kolosov et al. into the disclosure of Francisco et al. and arrive at the claimed invention. However, Kolosov et al. provide no guidance to screening lubricating oil composition samples for compatibility with elastomers, under program control. Rather, Kolosov et al. simply disclose in paragraph [0042] that the present invention may be used to screen or test most any material that may be a

commercial product itself or may be an ingredient or portion within a commercial product such as a lubricant. Kolosov et al. further disclose that the material such as a lubricant is tested for rheological properties. Even assuming, arguendo, that the material tested in Kolosov et al. is a non-flowable material, nothing in Kolosov et al. would lead one skilled in the art to modify the test disclosed in Example 3 of Francisco et al. and arrive at the present claimed high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control. Only by using Appellant's disclosure as a guide has the Examiner been able to piece together the claimed invention.

Third, appellant respectfully disagrees with the Examiner's statement in section (9) on page 6 of the Examiner's Answer where the Examiner sets forth his reasoning in rejecting appealed Claims 33-35 under 35 U.S.C. §103(a) as being obvious over Francisco et al. in view of Kolosov et al. that:

In response to appellants arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208USPQ 871 (CCPA 1981); *In re Merk & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Here, elastomer compatibility data is provided by Francisco et al in table 2. Storage on a computer controller is provided by Kolosov et al in paragraph 0093, which states "For storage and/or manipulation of data such as the responses of samples, the material properties of samples, combinations thereof or the like, it may be desirable for the data to be received within one of the computer sub-systems."

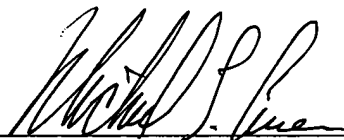
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claimed high throughput method for screening lubricating oil composition samples for compatibility with elastomers, under program control. As such, one skilled in the art would not look to the disclosure of Kolosov et al. to modify the elastomer compatibility data shown in Table 2 in Francisco et al. and arrive at a combinatorial lubricating oil composition library. Only by using Appellant's disclosure as a guide has the Examiner been able to piece together the claimed invention.

For the foregoing reasons, the Examiner has failed to show that all of the recitations of appealed Claims 1-3, 5-9, 11-14, 17-21 and 33-35 are taught or suggested by the prior art. Accordingly, appealed Claims 1-3, 5-9, 11-14, 17-21 and 33-35 are not rendered unpatentable by Francisco et al. and Kolosov et al. and are therefore allowable.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. §§1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 50-3591. **TWO (2) COPIES OF THIS SHEET ARE ENCLOSED.**

Dated: October 29, 2008

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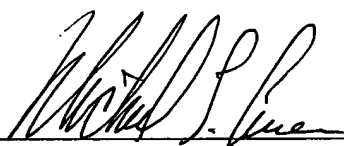
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